

Appl. No. 09/734,752
 Amdt. Dated June 21, 2004
 Response and Amendment

REMARKS

The Office Action mailed March 19, 2004 has been carefully reviewed and the foregoing amendments are made in response thereto. In view of the amendments and the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. By these amendments, the Applicants do not acquiesce to the propriety of any of the Examiner's rejections and do not disclaim any subject matter to which Applicants are entitled. It is respectfully submitted that no new matter has been introduced by the present amendments and entry of the same is respectfully requested.

Although Applicants respectfully traverse each of the Examiners rejections of claims 2, and 4-6, these claims have been canceled herein without prejudice. Applicants reserve the right to pursue the subject matter of the canceled claims in a separate application. Claims 10-12 have been added to more distinctly claim Applicants' methods of diagnosing endometrial cancer. Support for newly added claim 10 may be found in example 2 and Table 5 on page 37. Support for newly added claims 11 and 12 may be found in example 3 and Table 7 on page 39.

35 U.S.C. § 112 Rejections

Newly added claims 10-12 meet the requirements of § 112 first and second paragraph. The newly added claims are directed to methods of diagnosing endometrial cancer by detecting expression of specific genes in endometrial samples.

Rejections Under 35 U.S.C. § 102(e)

In paragraph 9 claims 2 and 5 were rejected in view of Srinivasan et al. (Clinical Cancer Research (1999) 5:2877-2883.) Srinivasan et al. compared the levels of 5 selected proteins in normal endometrial and endometrial adenocarcinoma cases and between secretory and proliferative phases of the menstrual cycle. The genes examined were c-erbB-3, c-erbB-4, betacellulin, neuregulin α and neuregulin β .

In paragraph 10 claims 2 and 4-6 were rejected in view of Baban et al. (Pub. No. US 2002/0127555). Baban et al. provides methods for identification of genes that are differentially expressed between normal endometrium and samples with endometriosis, a

Appl. No. 09/734,752
Amdt. Dated June 21, 2004
Response and Amendment

common gynecological disorder. Baban et al. fails to teach methods for diagnosing endometrial cancer or genes that are differentially expressed between normal samples and samples with endometrial cancer.

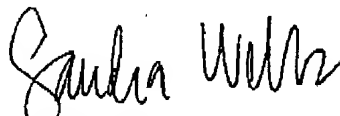
In paragraph 11 claims 2, 5 and 6 were rejected in view of Nowak et al. (USPN 6,440,445). Nowak et al. disclose growth factors that are differentially expressed in leiomyomas of the myometrium and not genes that are differentially expressed in different endometrial tissue.

In paragraph 12 claims 2 and 5 were rejected in view of Lessey, B. (USPN 5,854,401). Lessey discloses methods of diagnosing infertility and methods of monitoring endometrial maturation by monitoring the expression of a subunit of integrin using a monoclonal antibody. Lessey does not teach genes that are differentially expressed in normal and cancerous endometrium.

CONCLUSION

For these reasons, Applicants believe all pending claims are now in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at (408) 731-5768. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account 01-0431.

Respectfully submitted,



Sandra Wells
Reg. No.: 52,349

Date: June 22, 2004
Legal Department
Affymetrix, Inc.
3380 Central Expressway
Santa Clara, CA 95051
Tel: 408/731-5000
Fax: 408/731-5392